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Filing date: **04/30/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
Correspondence Address	ALAN S. COOPER HOWERY SIMON ARNOLD & WHITE LLP 1299 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 UNITED STATES lapidusn@howrey.com, ipdocketing@howrey.com, figginsl@howrey.com, coopera@howrey.com
Submission	Other Motions/Papers
Filer's Name	Alan S. Cooper
Filer's e-mail	coopera@howrey.com, lapidusn@howrey.com, mckeons@howrey.com, ipdocketing@howrey.com
Signature	/Alan S. Cooper/
Date	04/30/2009
Attachments	Motion for Leave to File Amended Notice of Opposition.pdf ( 17 pages )(677634 bytes ) Memo in Support of Motion for Leave to File an Amended Notice of Opposition.pdf ( 13 pages )(456795 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91164764
	)	
BRINKMANN CORPORATION	)	
	)	
Applicant	)	

MOTION FOR LEAVE TO FILE  
AMENDED NOTICE OF OPPOSITION

Opposer Brink's Network, Inc., in accordance with Rule 15 Fed. R. Civ. P. and § 2.107(a) of the Trademark Rules of Practice, respectfully moves the Trademark Trial and Appeal Board for leave to amend the Notice of Opposition in the subject proceeding. The Amended Notice of Opposition submitted herewith pleads as an additional ground for opposition that Application Serial No. 76/483,115 (hereinafter the "opposed application") contains a fraudulent representation as to the date of first use of the mark BRINKMANN in connection with the specific goods in International Class 9 which are the subject of the present opposition.

The grounds for this motion are as follows:

- (1) The opposed application, filed on January 17, 2003, seeks registration of the mark BRINKMANN for the following goods in Class 9: "home security systems and components therefor,

namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets; batteries; wall mount brackets for battery chargers and flashlight; cooking thermometers; electrical extension cords; electric connectors; electric converters; electronic mineral and metal detectors, flashlight and spotlight accessories sold together or separately, namely, transmitters, lighter plugs and filter caps.”

- (2) The opposed application asserts that the date of first use of the mark BRINKMANN in connection with all of the goods in International Class 9 is “[a]t least as early as June 12, 1978.”
- (3) The Notice of Opposition in this proceeding, filed on April 1, 2005, is directed only to registration of the mark BRINKMANN for home security systems and components therefor, namely motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets in International Class 9 (hereinafter “home security systems and components”).
- (4) Paragraph 3 of the Notice of Opposition alleges that the June 12, 1978 date of first use stated in the opposed application with respect to all of the goods in International Class 9 is not applicable to the home security systems and components in International Class 9.
- (5) Paragraph 3 of Applicant’s Answer to Notice of Opposition, filed on or about May 13, 2005, admits that the June 12, 1978, date of first use “is not applicable to its home security systems and components

(as properly defined).” Consistent with the admission in ¶ 3 of Applicant’s Answer, Applicant’s original and supplemental Answer to Opposer’s Interrogatory No. 3 states that the “date of first use for the mark BRINKMANN in connection with home security products was at least as early as October 1989.”

- (6) The opposed application was executed on November 22, 2002, by J. Baxter Brinkmann, President of Applicant, who declared subject to 18 U.S.C. § 1001 that all statements in the application are true.
- (7) Mr. Brinkmann either knew or should have known, as admitted in ¶ 3 of Applicant’s Answer, that the mark BRINKMANN was not used in connection with Applicant’s home security systems and components at least as early as June 12, 1978.
- (8) Where the date of first use does not pertain to all items in a single class, § 903.09 of the Trademark Manual of Examining Procedure (hereinafter “TMEP § 903.09”) instructs the applicant to designate the particular item(s) to which the specified date pertains.
- (9) The opposed application does not comply with TMEP § 903.09.
- (10) Applicant’s failure to comply with TMEP § 903.09 resulted in a misrepresentation of the date of first use of the mark BRINKMANN with respect to home security systems and components.
- (11) Applicant’s non-compliance with TMEP § 903.09 constitutes a material misrepresentation because if more than one item of goods or services is specified in a particular class, the U.S. Patent

and Trademark Office presumes that the date of use applies to all the goods or services, unless the applicant states otherwise.

- (12) Accordingly, if the present opposition had not been filed, it would have resulted in the issuance of a registration that contains an admittedly false statement as to the date of first use for home security systems and components.
- (13) Granting Opposer leave to file the Amended Notice of Opposition will not adversely prejudice Applicant because the parties are currently engaged in discovery, and Applicant will have a sufficient opportunity to take discovery directed to the alleged fraudulent representation before discovery closes on May 29, 2009, particularly in light of the agreement reached by the parties to extend the discovery deadline to June 30, 2009.<sup>1</sup>
- (14) However, because all of the facts related to the fraudulent misrepresentation should be in the possession of Applicant, there would seem to be little discovery that Applicant would need to take. If necessary, Opposer is willing to stipulate to a further reasonable extension of the discovery period and subsequent dates to accommodate any discovery that Applicant wishes to take directed to the fraudulent representation claim.

For the reasons set forth above, Opposer requests that the Board grant its Motion for Leave to Amend the Notice of Opposition. A Memorandum in support


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<sup>1</sup> Opposer consented to Applicant's request to extend the discovery deadline until June 30, 2009. Opposer expects Applicant to file a consent motion requesting Board approval of that extension in due course.

of Opposer's Motion and the Amended Notice of Opposition are submitted concurrently herewith.

BRINK'S NETWORK, INC.

Date: April 30, 2009

By:   
Alan S. Cooper  
Nancy S. Lapidus  
Howrey LLP  
1299 Pennsylvania Avenue, NW  
Washington, DC 20004-2402  
202.783.0800  
202.383.7195 (Facsimile)

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Motion for Leave to File Amended Notice of Opposition and Amended Notice of Opposition were served on the following attorneys of record for Applicant by Federal Express overnight courier service on this 30th day of April, 2009:

Gary A. Clark, Esq.  
Susan Hwang, Esq.  
Sheppard, Mullin, Richter & Hampton LLP  
333 South Hope Street, 48th Floor  
Los Angeles, California 90071



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91164764
	)	
THE BRINKMANN CORPORATION	)	
	)	
Applicant	)	

AMENDED NOTICE OF OPPOSITION

Brink's Network, Incorporated, a Delaware corporation, located and doing business at 203 Bancroft Building, 3411 Silverside Road, Wilmington Delaware 19810 (hereinafter "Opposer"), believes that it will be damaged by registration of the mark shown in Application Serial No. 76/483,115 with respect to certain of the goods described in said Application as alleged more fully below, and hereby opposes same.

The grounds for the opposition are as follows:

BACKGROUND

(1) Application Serial No. 76/483,115 (hereinafter the "opposed application"), as amended pursuant to the Order of the Board entered in this proceeding on June 28, 2005, seeks registration of the mark BRINKMANN for, *inter alia*, home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets in International Class 9 (hereinafter "home security systems and components").



(2) The opposed application was filed on January 17, 2003, based on a claim of Applicant's use of the mark BRINKMANN in interstate commerce in connection with home security systems and components on June 12, 1978.

(3) On information and belief, the June 12, 1978 date of first use stated in the opposed application with respect to the goods in International Class 9 is not applicable to the home security systems and components sold by Applicant under the mark BRINKMANN.

(4) Long prior to the January 17, 2003 filing date of the opposed application and the true date of Applicant's first use of the mark BRINKMANN in connection with home security systems and components, Opposer's predecessor adopted and used, and Opposer's related companies Brink's Home Security Inc. and Brink's, Incorporated are still using the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s), in interstate commerce for commercial and residential security systems and equipment; residential and commercial security alarm and monitoring services; check and payroll processing and security services; and convention, exhibit and performance ticket sales and security services.

(5) Long prior to the January 17, 2003 filing date of the opposed application and the true date of Applicant's first use of the mark BRINKMANN in connection with home security systems and components, Opposer's predecessor adopted and used, and Opposer's related companies Brink's Home Security Inc. and Brink's, Incorporated are still using the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s), in interstate commerce for commercial and residential security systems and equipment; residential and commercial security alarm and

monitoring services; check and payroll processing and security services; and convention, exhibit and performance ticket sales and security services.

(6) In accordance with § 5 of the Federal Trademark Act, all use of the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s), by Opposer's related companies Brink's Home Security Inc. and Brinks, Incorporated inures to the benefit of Opposer.

(7) Opposer is the owner of the trade name, trademark and service mark BRINK'S. Opposer and its predecessor and related companies have continuously used the trade name and mark BRINK'S for commercial and residential security systems and related residential and commercial security alarm and monitoring services, among other goods and services, since long prior to the filing date of the opposed application and the true date of first use of the mark BRINKMANN by Applicant in connection with home security systems and components.

(8) Opposer's related company Brink's Home Security Inc. offers for sale and sells numerous residential and commercial security products and related services under the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s).

(9) By virtue of the prior and continuous advertising and sales of commercial and residential security systems and related services under the mark BRINK'S, and the maintenance of premium quality standards relating thereto, purchasers of such goods and services and others have come to recognize the mark BRINK'S as a singular, highly distinctive indication of origin, as a consequence of which Opposer has established valuable goodwill and exclusive rights in this mark.

(10) The mark BRINK'S, alone and/or in combination with other words and design(s), had become exceedingly well-known and a famous mark within the meaning of § 43(c)(2)(A) of the Federal Trademark Act long prior to the filing date of the opposed application and the true date of Applicant's first use of the mark BRINKMANN in connection with home security systems and components.

(11) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S & Design for security transportation, namely, armored car transport services of currency, securities and other valuables; domestic and international air courier services; receiving and cashing checks for others, coin processing and wrapping and change services; payroll preparation and consolidation of deposits for others; cash maintenance of bank automatic teller stations; food stamp distribution services; selling tickets and handling proceeds from conventions, exhibits and performances for others in the United States Patent and Trademark Office under Registration No. 1,313,790 which issued January 8, 1985 and has been duly renewed. Opposer is the record owner of Registration No. 1,313,790 by virtue of an assignment recorded in the Assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(12) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S (Stylized) for receiving checks; cashing the same; making up payrolls; carrying same or other moneys or securities; guarding and protecting same and paying payrolls; handling clearings; selling tickets; handling proceeds from conventions, exhibitions, and performances; repairing safes, chests, cash protectors and similar equipment in the United States Patent and Trademark Office under Registration No. 529,622 which issued August 22, 1950 and has been duly renewed. Opposer is the record owner of Registration No.

529,622 by virtue of an assignment recorded in the Assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(13) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S for security transportation, namely, armored car transport services of currency, securities, and other valuables; domestic and international air courier services; air transport and air freight of goods in the United States Patent and Trademark Office under Registration No. 1,309,375 which issued December 11, 1984 and has been duly renewed. Opposer is the record owner of Registration No. 1,309,375 by virtue of an assignment recorded in the Assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(14) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S HOME SECURITY for security alarm and monitoring system services in the United States Patent and Trademark Office under Registration No. 1,412,587 which issued October 7, 1986. Opposer is the record owner of Registration No. 1,412,587 by virtue of an Assignment recorded in the assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(15) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S & Design for security alarm and monitoring system services in the United States Patent and Trademark Office under Registration No. 1,411,610 which issued on September 30, 1986. Opposer is the record owner of Registration No. 1,411,610 by virtue of an assignment recorded in the assignment Branch on April 19, 1996 at Reel, 1452, Frame 0600.

(16) Opposer duly registered the mark BRINK'S HOME SECURITY & Design for residential and commercial metal safes; keyed and combination metal locks; non-

metal residential and commercial safes under Registration No. 2,330,884 which issued March 21, 2000.

(17) Opposer duly registered the mark BRINK'S for intrusion detection computer hardware and software for detecting and indicating undesirable Internet signals and communications prior to entry to a customer's computer network and monitoring signals from computer network intrusion detection systems in the United States Patent and Trademark Office under Registration No. 2,691,470 which issued February 25, 2003.

(18) Opposer duly registered the mark BRINK'S & Design for intrusion detection computer hardware and software for detecting and indicating undesirable Internet signals and communications prior to entry to a customer's computer network and monitoring signals from computer network intrusion detection systems in the United States Patent and Trademark Office under Registration No. 2,646,784 which issued November 5, 2002.

(19) Registration Nos. 1,313,790, 529,622, 1,309,375, 1,412,587, 1,411,610, 2,330,884, 2,691,470, and 2,646,784 are *prima facie* evidence of the validity thereof and Opposer's ownership and exclusive right to use the marks BRINK'S HOME SECURITY, BRINK'S HOME SECURITY & Design, BRINK'S, BRINK'S & Design, and BRINK'S (Stylized), respectively, in commerce and are constructive notice of Opposer's ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act of 1946, as amended. The right to use the marks BRINK'S HOME SECURITY, BRINK'S, BRINK'S & Design, and BRINK'S (Stylized) having become incontestable, Registration Nos. 1,313,790, 529,622, 1,309,375, 1,412,587 and 1,411,610, are conclusive evidence of

Opposer's exclusive right to use the marks shown therein in commerce as provided by §§ 15 and 33(b) of the Federal Trademark Act.

OPPOSITION BASED ON LIKELIHOOD  
OF CONFUSION PURSUANT TO § 2(d)

(20) The commercial and residential security systems and equipment, and related residential and commercial security alarm and monitoring services described in Opposer's Registration Nos. 1,313,790, 529,622, 1,309,375, 1,412,587, 1,411,610, 2,330,884, 2,691,470, and 2,646,784 and the home security systems and components therefor described in the opposed application are commercially related, and are likely sold and/or rendered to the same or overlapping classes of purchasers. Therefore, purchasers, prospective purchasers and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's home security systems and components therefor sold under the mark BRINKMANN emanate from and/or are in some way sponsored or approved by Opposer and/or that Applicant is somehow affiliated with Opposer, thereby damaging Opposer.

(21) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that Applicant's mark BRINKMANN, as used in connection with the home security systems and components therefor described in the opposed application, so resembles Opposer's previously used and/or registered marks BRINK'S, BRINK'S & Design, BRINK'S (Stylized), BRINK'S HOME SECURITY, and BRINK'S HOME SECURITY & Design as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Opposer.

OPPOSITION BASED ON LIKELIHOOD  
OF DILUTION PURSUANT TO § 13(a)

(22) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that its use of the mark BRINKMANN in connection with the home security systems and components described in the opposed application is likely to dilute the distinctiveness of Opposer's famous marks BRINK'S, BRINK'S & Design, BRINK'S (Stylized), BRINK'S HOME SECURITY, and BRINK'S HOME SECURITY & Design within the meaning of § 43(c) of the Federal Trademark Act, as amended.

OPPOSITION BASED ON MISUSE  
OF REGISTRATION SYMBOL

(23) Attached hereto as Exhibit A is a true copy of a specimen submitted by Applicant in connection with the opposed application showing use of the mark BRINKMANN in connection with home security systems and components that displays the federal statutory registration symbol ® in association with the mark BRINKMANN.

(24) Applicant does not own a subsisting federal registration of the mark BRINKMANN that covers home security systems and components.

(25) Applicant's use of the federal statutory notice of registration symbol ® in association with the mark BRINKMANN as shown in Exhibit A constitutes a misuse of that symbol in violation of § 29 of The Federal Trademark Act and deceives the consuming public into believing that the mark is registered, thereby damaging Opposer.

OPPOSITION BASED ON FRAUDULENT  
REPRESENTATION OF MATERIAL FACT

(26) The statement portion and the drawing page in the opposed application each state that June 12, 1978 is date of first use of the mark BRINKMANN in commerce in connection with all of the goods in International Class 9, including home security

systems and components. No other date of first use is provided for any of the International Class 9 goods listed in the application.

(27) Applicant has admitted that it did not use the mark BRINKMANN for home security systems and components as of June 12, 1978.

(28) The statements in the opposed application that Applicant commenced use of the mark BRINKMANN in commerce in connection with all goods in International Class 9 on June 12, 1978 accordingly are false.

(29) Section 903.09 of the Trademark Manual of Examining Procedure ("TMEP § 903.09") provides that, in the context of an applicant's statement regarding the date of first use of a mark, when the date of first use does not pertain to all items listed in a single class, the applicant should specify the goods within that multiple listing which actually correspond to the stated date of first use.

(30) In making the aforesaid knowing misstatement of material fact with respect to the date of first use of the mark BRINKMANN in connection with home security systems and components, Applicant failed to comply with TMEP § 903.09.

(31) Applicant's non-compliance with TMEP § 903.09 resulted in a material misrepresentation of fact because, if the present opposition had not been filed, it would have resulted in the issuance of a registration that contains an admittedly false statement as to the date of first use for home security systems and components.

(32) The opposed application was executed on November 22, 2002, by J. Baxter Brinkmann, President of Applicant, who declared subject to 18 U.S.C. § 1001 that all statements in the application are true.



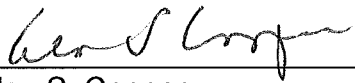
(33) Mr. Brinkmann either knew or should have known that the mark BRINKMANN was not used in connection with Applicant's home security systems and components at least as early as June 12, 1978.

(34) The aforesaid knowing misstatement of a material fact, namely, the June 12, 1978 date of first use of the mark BRINKMANN in connection with home security systems and components asserted in the opposed application, constitutes a fraudulent misrepresentation that renders the opposed application void *ab initio*.

WHEREFORE, Opposer believes that the present opposition should be sustained and the registration of Applicant's mark refused.

BRINK'S NETWORK, INCORPORATED

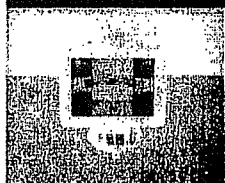
Dated: April 30, 2009

By:   
\_\_\_\_\_  
Alan S. Cooper  
Nancy S. Lapidus  
Attorneys for Opposer  
Howrey LLP  
1299 Pennsylvania Ave., N.W.  
Washington, D.C. 20004  
(202) 783-0800  
Fax: (202) 383-6610

**BRINKMANN®**

## Home Security

Motion Activated Lighting System



*Special two-way mounting design is suitable for ceilings and under eaves as well as wall mounting.*



*Easy to adjust, no tools are needed. Lighting time is adjustable for up to 12 minutes. Lux control allows you to set at what darkness level lights will come on.*



*The area of detection can be adjusted to cover over 1,500 sq. ft. with the wide angle sensor seeing up to 40 ft. away in a 110° arc.*

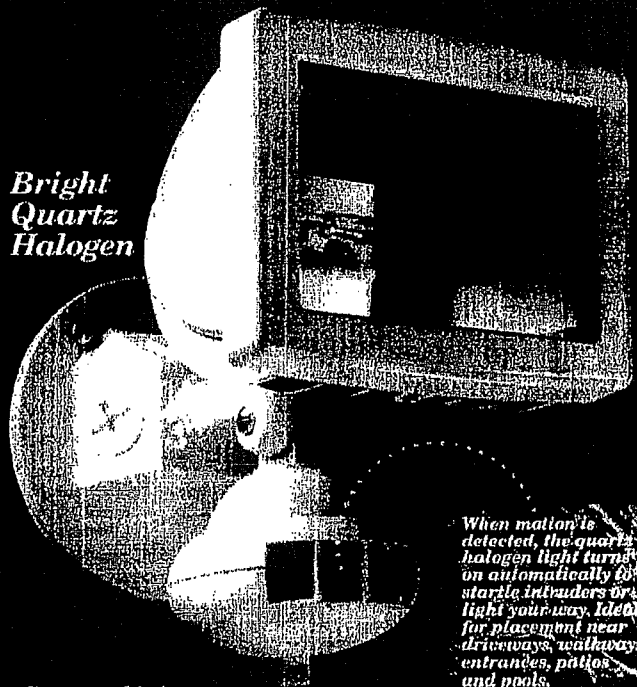
**BRINKMANN®**

## Home Security

Motion Activated Lighting System

**150 Watt/110°**  
*Motion does for with Quartz Halogen light included*

**Bright  
Quartz  
Halogen**



Pre-assembled

*When motion is detected, the quartz halogen light turns on automatically to startle intruders or light your way. Ideal for placement near driveways, walkways, entrances, patios and pools.*

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91164764
	)	
BRINKMANN CORPORATION	)	
	)	
Applicant	)	

MEMORANDUM IN SUPPORT OF  
MOTION FOR LEAVE TO FILE AN  
AMENDED NOTICE OF OPPOSITION

I. INTRODUCTION

This matter is before the Board on the motion of Opposer Brink's Network, Inc., in accordance with Rule 15 Fed. R. Civ. P. and § 2.107(a) of the Trademark Rules of Practice, to amend the Notice of Opposition in the subject proceeding. The Amended Notice of Opposition asserts a new claim of fraudulent procurement based on non-compliance with § 903.09 of the Trademark Manual of Examining Procedure (hereinafter "TMEP § 903.09") which resulted in a material misrepresentation with respect to the date of first use of the relevant goods recited in Application Serial No. 76/483,115 (hereinafter the "opposed application").

II. BACKGROUND

The opposed application was filed on January 17, 2003, and is based on a claim of use of the mark BRINKMANN in commerce under § 1(a) of the Federal Trademark Act. The opposed application was executed on November 22, 2002, by J. Baxter

Brinkmann, President of Applicant, who declared subject to 18 U.S.C. § 1001 that all statements in the application are true.

The opposed application seeks registration of the mark BRINKMANN for the following goods in Class 9: "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets; batteries; wall mount brackets for battery chargers and flashlight; cooking thermometers; electrical extension cords; electric connectors; electric converters; electronic mineral and metal detectors, flashlight and spotlight accessories sold together or separately, namely, transmitters, lighter plugs and filter caps."

The opposed application asserts that the date of first use of the mark BRINKMANN in connection with all of the goods in International Class 9 – including home security systems and components therefor, namely motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets (hereinafter "home security systems and components") – is "[a]t least as early as June 12, 1978." The June 12, 1978 date of first use is asserted both in the statement portion of the opposed application and the drawing page.

The Notice of Opposition in this proceeding was filed on April 1, 2005, and is directed only to registration of the mark BRINKMANN for home security systems and components in International Class 9. Paragraph 3 of the Notice of Opposition alleges that the June 12, 1978 date of first use stated in the opposed application with respect to the goods in International Class 9 is not applicable to home security systems and components.

Applicant's Answer to Notice of Opposition was filed on or about May 13, 2005. Paragraph 3 of the Answer -- which responds to ¶ 3 of the Notice of Opposition -- admits that the June 12, 1978 date of first use "is not applicable to its home security systems and components (as properly defined)." Consistent with the admission in ¶ 3 of Applicant's Answer, Applicant's original and supplemental Answers to Opposer's Interrogatory No. 3 state that the "date of first use for the mark BRINKMANN in connection with home security products was at least as early as October 1989."<sup>1</sup>

### III. ARGUMENT

In ruling on motions for leave to file an amended pleading, the Board usually is very liberal in accordance with the requirement of Rule 15 Fed. R. Civ. P. and will grant such motions provided the amended pleading does not prejudice the adverse party. *See, e.g., Commodore Electronics Ltd. v. Cbm Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In terms of whether a proposed amendment would prejudice the adverse party, the Board generally looks to the relative timing of the amendment. Where the motion for leave to file an amended pleading is filed prior to the close of the discovery period, there typically is no prejudice to the adverse party because that party will have an opportunity to take discovery on the matters raised in the proposed amended pleading, with the result that such motions generally are granted. *See, e.g., Commodore Electronics Ltd. v. Cbm Kabushiki Kaisha, supra; United States Olympic Committee v. O-M Bread Inc., supra;*

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<sup>1</sup> True copies of Applicant's original and supplemental Answers to Opposer's Interrogatory No. 3 are annexed hereto as Appendices A and B, respectively.

*Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992).

TMEP § 903.09 governs an applicant's statement regarding the date of first use of a mark when the date of first use does not pertain to all items listed in a single class. TMEP § 903.09 provides in pertinent part that "[w]here the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain."

It is undisputed that the June 12, 1978 date of first use does not apply to home security systems and components.<sup>2</sup> However, the opposed application does not specify the particular items in Class 9 to which the June 12, 1978 date of first use pertains. Applicant plainly did not comply with the specific, express instruction in TMEP § 903.09 to inform the U.S. Patent and Trademark Office that the June 12, 1978 date of first use does not apply to home security systems and components. This non-compliance with TMEP § 903.09 results in a material misrepresentation because, as clearly stated in that section, "[i]f more than one item of goods or services is specified in a particular class, *the Office will presume that the dates of use apply to all of the goods or services, unless the applicant states otherwise.*" (Emphasis added.)

Accordingly, Applicant's failure to comply with TMEP § 903.09 in this instance resulted in a material misrepresentation because, if the present opposition had not been filed, the U.S. Patent and Trademark Office acting in reliance on that material misrepresentation would have issued a registration that contains an admittedly false statement as to the date of first use for home security systems and components. See

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<sup>2</sup> Applicant's Answer ¶ 3; Applicant's original and supplemental Answers to Opposer's Interrogatory No. 3.

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 19:56.50 (4th ed. 2009).

It is respectfully submitted that Mr. Brinkmann, the President of Applicant who signed the application in question, either knew or should have known that the mark BRINKMANN had not been used in connection with Applicant's home security systems and components at least as early as June 12, 1978. Nevertheless, Mr. Brinkmann signed the application containing a false statement as to a material fact, namely, the first use of the mark BRINKMANN in commerce in connection with home security systems and components which is the predicate for registration under § 1(a) of the Federal Trademark Act. Accordingly, Mr. Brinkmann's knowing misstatement of fact with respect to the date of first use of the mark BRINKMANN in connection with home security systems and components constitutes a misrepresentation of a material fact that renders the opposed application void *ab initio*.

For the reasons stated above, the Amended Notice of Opposition presents a legitimate claim precluding registration that should be considered by the Board.

The proposed amendment will not adversely prejudice Applicant because the parties are currently engaged in discovery. Under the current scheduling order, the discovery cut-off date is May 29, 2009, but the parties have agreed to extend that deadline to June 30, 2009.<sup>3</sup> However, it is difficult to anticipate what type of discovery Applicant would need to take from Opposer or any third party to address a claim that is directed solely to Applicant's own knowledge and misconduct. As the Board noted in

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<sup>3</sup> Opposer consented to Applicant's request to extend the discovery deadline until June 30, 2009. Opposer expects Applicant to file a consent motion requesting Board approval of that extension in due course.


*Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 24 USPQ2d 1376, 1379 (TTAB 1992), in the context of the petitioner's claimed need for discovery in that case, "[d]iscovery is unnecessary in order for petitioner to discover what it knew and when it knew it." Nevertheless, if Applicant believes it needs additional time to take discovery directed to the fraudulent representation claim, Opposer is willing to stipulate to a reasonable extension of the discovery period for that purpose and to extend the subsequent testimony and trial dates accordingly.

#### IV. CONCLUSION

For the reasons set forth above, Opposer requests that the Board grant its Motion for Leave to File an Amended Notice of Opposition.

BRINK'S NETWORK, INC.

Date: April 30, 2009

By: 

Alan S. Cooper  
Nancy S. Lapidus  
Howrey LLP  
1299 Pennsylvania Avenue, NW  
Washington, DC 20004-2402  
202.783.0800  
202.383.7195 (Facsimile)

Attorneys for Opposer



CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Memorandum in Support of Opposer's Motion for Leave to File Amended Notice of Opposition was served on the following attorneys of record for Applicant by Federal Express overnight courier service on this 30th day of April, 2009:

Gary A. Clark, Esq.  
Susan Hwang, Esq.  
Sheppard, Mullin, Richter & Hampton LLP  
333 South Hope Street, 48<sup>th</sup> Floor  
Los Angeles, California 90071

  
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# Appendix A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED,

Opposer,

v.

THE BRINKMANN CORPORATION,

Applicant.

Opposition No. 91164764

**APPLICANT BRINKMANN'S RESPONSES TO OPPOSER BRINK'S  
NETWORK'S FIRST SET OF INTERROGATORIES**

Pursuant to FED. R. CIV. P. 33 and 37 C.F.R. § 2.120, Applicant The Brinkmann Corporation ("Brinkmann") hereby responds to OPPOSER BRINK'S NETWORK, INCORPORATED'S FIRST SET OF INTERROGATORIES served by Opposer Brink's Network, Incorporated ("Brink's Network") by mail on September 6, 2005.

**GENERAL OBJECTIONS**

1. Brinkmann objects to each interrogatory insofar as it is vague, overly broad, oppressive, harassing or vexatious; imposes burden or expense that outweighs its likely benefit; seeks a legal conclusion; and/or seeks information not relevant to the claim or defense of any party.

**INTERROGATORY NO. 3:**

State Applicant's date of first use and date of first use in commerce of the mark BRINKMANN in connection with home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets.

**RESPONSE TO INTERROGATORY NO. 3:**

Subject to and without waiving the General Objections, which are incorporated by reference, Brinkmann states that the date of first use for the mark BRINKMANN in connection with home security products was at least as early as October 1989.

Brinkmann reserves the right to amend and/or supplement this response as its investigations and discovery progress.

**INTERROGATORY NO. 4:**

Identify the person(s) responsible for the decision of Applicant to commence use of the mark BRINKMANN in connection with home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets, and describe the circumstances surrounding Applicant's decision, including but not limited to the date on which Applicant made its decision.

**RESPONSE TO INTERROGATORY NO. 4:**

In addition to the grounds set forth in the General Objections, which are incorporated by reference, Brinkmann objects to this interrogatory on the following grounds:

Brinkmann objects to this interrogatory as vague and ambiguous in that it is not clear what Brink's Network means by "circumstances surrounding Applicant's decision".

# Appendix B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BRINK'S NETWORK, INCORPORATED,

Opposer,

v.

THE BRINKMANN CORPORATION,

Applicant.

Opposition No. 91164764

**APPLICANT BRINKMANN'S FIRST AMENDED AND SUPPLEMENTAL  
RESPONSES TO OPPOSER BRINK'S NETWORK'S FIRST SET OF  
INTERROGATORIES**

Pursuant to FED. R. CIV. P. 33, Applicant The Brinkmann Corporation ("Brinkmann") hereby amends and supplements its responses to OPPOSER BRINK'S NETWORK, INCORPORATED'S FIRST SET OF INTERROGATORIES served by Opposer Brink's Network, Incorporated ("Brink's Network") by mail on September 6, 2005.

**GENERAL OBJECTIONS**

1. Brinkmann objects to each interrogatory insofar as it is vague, overly broad, oppressive, harassing or vexatious; imposes burden or expense that outweighs its likely benefit; seeks a legal conclusion; and/or seeks information not relevant to the claim or defense of any party.

**INTERROGATORY NO. 3:**

State Applicant's date of first use and date of first use in commerce of the mark BRINKMANN in connection with home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets.

**RESPONSE TO INTERROGATORY NO. 3:**

Subject to and without waiving the General Objections, which are incorporated by reference, Brinkmann states that the date of first use for the mark BRINKMANN in connection with home security products was at least as early as October 1989.

Brinkmann reserves the right to amend and/or supplement this response as its investigations and discovery progress.

**INTERROGATORY NO. 4:**

Identify the person(s) responsible for the decision of Applicant to commence use of the mark BRINKMANN in connection with home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets, and describe the circumstances surrounding Applicant's decision, including but not limited to the date on which Applicant made its decision.

**RESPONSE TO INTERROGATORY NO. 4:**

In addition to the grounds set forth in the General Objections, which are incorporated by reference, Brinkmann objects to this interrogatory on the following grounds:

Brinkmann objects to this interrogatory as vague and ambiguous in that it is not clear what Brink's Network means by "circumstances surrounding Applicant's decision".